



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,272	11/30/2000	Rabindranath Dutta	AUS9-2000-0650-US1	5240

7590 04/14/2003

Joseph T. Van Leeuwen
P.O. Box 81641
Austin, TX 78708-1641

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,272

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1-36 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6-10, 13-15, 18-22, 25-27 and 30-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rosenberg, U.S. Patent No. 6,363,357.

As per claims 1-3, 6-10, 13-15, 18-22, 25-27 and 30-34, Rosenberg et al teach a system for obtaining digital content comprising:

- obtaining one or more product identifiers from one or more providers (figures 2 and 5)
- receiving a product sale identifier from a merchant (figures 2 and 5; column 6, lines 28-39 and 55-67)

- identifying a product identifier that corresponds to the product sale identifier (figures 2 and 6)
- storing a sales record in response to receiving the product sale identifier (column 9, lines 27-39; column 10, lines 54-67; column 11, lines 36-44)
- receiving a royalty rate corresponding to the product identifier and calculating an account balance for the merchant (figures 6 and 8; column 2, lines 43-67; column/line 7/53-8/19; column 9, lines 28-40)
- receiving a payment, based on the received royalty rate, from the merchant in response to receiving the product sale identifier (figure 6)
- receiving payment from the merchant's account balance and modifying the account in response to the receiving of payment (figure 6)
- receiving one or more digital works from a provider, storing the work in non-volatile storage, receiving a download request from a merchant computer, downloading the digital work by the merchant (abstract; column 10, lines 14-44; column 11, lines 25-35)
- receiving a royalty rate from a provider and providing it to a merchant (figures 1, 2 and 5)

- registering merchants and providers with a third party and allowing access to the system post-registration (figures 3-5; column/line 3/25-4/7; column/line 4/22-5/33)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 16, 17, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg, U.S. Patent No. 6,363,357 in view of Berstis et al., U.S. Patent No. 6,282,653.

As per claims 4, 5, 16, 17, 28, and 29, Rosenberg et al. teach a system for obtaining digital content that comprises compensating content owners for the use of their works (figure 6). However, Rosenberg et al. do not explicitly recite calculating provider account balances. Berstis et al. teach a royalty collection method that maintains, modifies and calculates provider account balances and transfers funds to a provider (column 8, lines 7-35). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rosenberg and

Berstis et al. in order better manage the collection and allocation of royalties due providers ('653, column 2, lines 14-22 and 63-67).

6. Claims 11, 12, 23, 24, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg, U.S. Patent No. 6,363,357 in view of Kauffman et al., U.S. Patent No. 5,787,413.

As per claims 11, 12, 23, 24, 35 and 36, Rosenberg et al. teach a system for obtaining digital content that comprises compensating content owners for the use of their works (figure 6). However, Rosenberg et al. do not specifically recite determining whether a merchant is registered in with a third party in response to a provider's inquiry. Kauffman et al. teach a digital library that includes the determining a merchant's registration at the start of a merchant session (column 1, lines 43-56; column 2, lines 15-23 and 59-67). Therefore, it would have been obvious to one of ordinary skill to combine the systems of Rosenberg et al. and Kauffman et al.. The motivation is as follows:

By requiring merchants who desire access to content to provide the system with a name and password, access authorization to a data object ('413, column 2, lines 59-67) can be determined based on, for example, a comparison of merchant's age ('413, column 3, lines 1-5) and content rating ('357, figure 7).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Nutall teaches a system for collecting payments, including royalty payments, for the right to access digital content
- Payne et al. disclose a network sales system that allows users to obtain digital content
- Wolfe et al. teach music on demand over the internet

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and
after-final communications),

or:

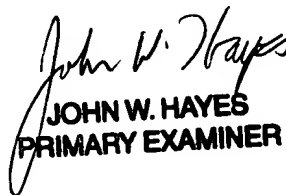
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

April 4, 2003


JOHN W. HAYES
PRIMARY EXAMINER